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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,525	10/24/2003	Anthony J. Presby	23708.00	7430

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EXAMINER

AVERY, BRIDGET D

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/691,525

Applicant(s)

PRESBY, ANTHONY J.

Examiner

Bridget Avery

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/24/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Information Disclosure Statement filed by applicant on October 24, 2003 is acknowledged and has been considered.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The following title is suggested: "Mud Restraint Motorcycle Fender and Liner Assembly and Method of Forming a Mud Resistant Protective Liner".

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: on line 3, "an" should be changed to --and--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer et al. (US Patent 5,582,430).

Bauer et al. teaches a mud resistant/spray protection device and assembly for any type of vehicle (as taught in column 2, lines 49-55) fender/wheel cover, mudguard, splash guard or skirt, including: an air permeable liner dimensioned and configured for attachment to a lower surface of a vehicle fender/wheel cover, mudguard, splash guard or skirt. The liner is made of a flexible compressible material. Note, air can permeate through the pile fabric (10) forming the inlet layer (14) and the water passage openings (28) in the pile fabric (10). Further note, the flexibility of the liner is clearly described in column 4, lines 1-24. It is old and well known that pile refers to the soft, resilient/compressible surface of fabric.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 4-9, 11, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. ('430).

Bauer et al. teaches the features described above. Bauer et al. further teaches a liner made of thermoplastic mass injection-molded or applied in any other manner to the material web; projections formed by wire bristles, projections consisting of a textile material web such as any woven fabric, weft-knitted fabric, knitted fabric, fleece (also needle fleece of any desired textile material, of metal wire or of plastic fibers and/or

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plastic ribbons, as taught in column 2, lines 36-43 and column 3, lines 20-26. Bauer attaches the liner to a mudguard, splash guard or wheel cover/fender using screws, bolts, pins with resilient securing elements or the like, as taught in column 6, lines 1-2. Bauer also teaches backing material including a woven mesh of monofilament fibers in the form of wire mesh, as taught in column 5, lines 23-36. Bauer teaches that it is known to connect elements using jointing processes, such as welding, glueing/adhesive bonding, connecting by means of mechanical connecting elements, sewing or the like, as well as with or without additional auxiliary materials, as set forth in column 4, lines 25-31.

Bauer et al. lacks the teaching of attaching the liner/spray protection device to the wheel cover/fender using adhesive bonding. Bauer et al. lacks the teaching of an open-cell material. Bauer et al. fails to disclose the thickness of the liner. Bauer et al. fails to disclose the exact position of the liner with respect to the lower edge of the wheel cover/fender.

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to manufacture the liner of a synthetic material approximately one fourth of an inch thick, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to make the liner using an open-cell material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In this case,

the use of an open-cell material would have been an obvious choice for durability and flexibility. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to connect the liner/spray protection device to the wheel cover/fender using a layer of adhesive bonding, since Bauer et al. states at column 4, lines 27-29 that such a selection in connection process could depend on the materials used. The selection of a layer of adhesive bonding would be a cost effective means for connection to keep manufacturing cost low. It would have been obvious to one having ordinary skill in the art, at the time the invention was made to position the liner to extend to within approximately ¼ inch of a lower edge of the wheel cover/fender to protect a substantial portion of the wheel cover/fender. With respect to claims 13, 14 and 16, it is the examiner's position that the method of forming a mud resistant liner/spray protection device on a vehicle including the steps of preparing the surface for application of an adhesive by removing loose material from the surface and abrading the surface; applying a first layer of adhesive to the surface; firmly applying backing material to the first layer of adhesive, applying a second layer of adhesive to the backing material; firmly applying a layer of synthetic, air permeable material to the second adhesive layer; and applying a roller to the air permeable material is obvious in view of Bauer et al. to reduce assembly time.

7. Claims 10, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. ('430) in view of Finnson (US Patent 5,700,022).

Bauer et al. teaches the features described above.

Bauer et al. lacks the teaching of a bead of sealant disposed around the edge of the liner/spray protection device.

Finnson teaches a heat seal (24) shown as a bead seal attaching the sheet (12) to the panel (14).

Based on the teachings of Finnson, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the liner/spray protection device of Bauer et al. to include a heat/bead seal between the liner/spray protection device and the wheel cover/fender to form a weather-tight seal between the liner and fender to inhibit detachment of the liner. With respect to claims 15 and 17, it is the examiner's position that the method of forming a mud resistant liner/spray protection device on a vehicle including the steps of applying heat in order to raise the surface to a sufficient temperature to achieve a strong bond between the protective liner, the backing material, and the surface; and, the step of applying a bead of waterproof sealant around the protective liner and the backing material is obvious in view of Bauer et al. and Finnson to form a durable and long-lasting weatherproof seal and prevent unintentional detachment of the liner from the fender.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent 3,934,900) in view of Bauer et al. ('430).

Wilson teaches a fender and splashguard attached to a motorcycle. The fender includes an upper surface and a concave lower surface.

Wilson lacks all other elements.

Bauer et al. teaches the mud resistant liner/spray protection device described above including a mesh backing.

Based on the teachings of Bauer et al., it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add a liner/spray protection device to the fender of Wilson to reduce the spray occurring behind a traveling vehicle and produced by wheels running on wet roads. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to connect the mesh backing to the fender using adhesive bonding and to connect the liner to the mesh backing using adhesive bonding, since Bauer et al. states at column 4, lines 27-29 that such a selection in connection process could depend on the materials used. The selection of an adhesive bonding would be a cost effective means of connection to keep manufacturing cost low.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jain et al. shows a splash and spray suppressor.

Dodt shows an arrangement for reducing tire/road noise.

Stricker shows a sound absorber for motor vehicles.

Lavicska shows a lamp/heater for a wheel well in a motor vehicle.

Stief et al. shows a wheel lining.

Fuchs shows a wheel housing lining for motor vehicles.



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Gray shows a splash and spray suppressor for vehicles.

Mantarro shows a spray-suppression device.

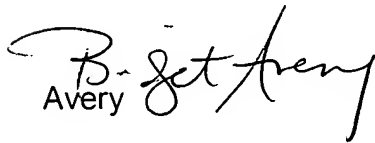
Oswald shows an acoustically absorbent truck tire splashguard.

Reddaway shows a splash and spray-reducing device for a vehicle.

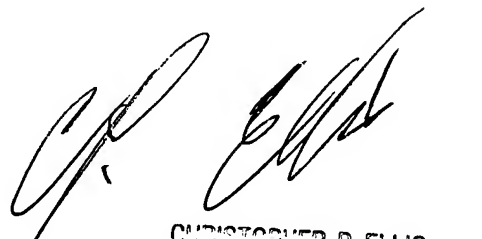
Rich shows a tricycle with steerable rear wheels.

Mosher shows a detachable lining for mudguards.

10. Any inquiry concerning this communication should be directed to Bridget Avery at telephone number 703-308-2086.

  
Avery

March 30, 2005

  
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